

ROACH, BROWN, McCARTHY & GRUBER, P.C.

1620 Liberty Building
Buffalo, New York 14202
(716) 852-0400
FAX
(716) 852-2535

TO: Andrew Freistein - Airt Unit 1626
COMPANY: USPTO
FAX NO.: 1-571-273-8515
FROM: Kevin D. McCarthy
RE: 10/512,024 (0-06-224/16120/US/03)
DATE: June 4, 2007

NUMBER OF PAGES TRANSMITTED: COVER+_13

MESSAGE: Per telephone conference, we are re-transmitting
just the response ~~at~~ and claims of April 30, 2007
and without a line running through it.

PLEASE CONTACT _____ IMMEDIATELY IF ALL PAGES ARE NOT
RECEIVED OR IF WE ARE DISCONNECTED DURING TRANSMISSION.

NOTICE TO RECIPIENT: The information contained in this facsimile transmission is attorney privileged and confidential information intended solely for the use of the addressee named above. If the reader of this message is not the intended recipient, you are hereby notified that any dissemination, distribution or copying of this communication is strictly prohibited. If you have received this communication in error, please immediately notify us by telephone and return the original facsimile transmission to us by mail.

Thank you.

Certificate of Mailing or Transmission

I, the undersigned, hereby certify that this correspondence along with other possible documents has been deposited with the U.S. Postal Service by first class mail, postage pre-paid, in an envelope addressed to the Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, or facsimile transmitted to the U.S. Patent and Trademark Office on April 30, 2007.

Typed Name: *Kevin D. McCarthy*
Date: April 30, 2007

Patent 0-06-224/16120/US/03

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor: Haj-Yehia, Abdullah I.
Serial no.: 10/512,024
I.A. Filed: April 15, 2003
Title: BETA-AGONIST COMPOUNDS COMPRISING NITRIC OXIDE DONOR GROUPS AND REACTIVE OXYGEN SPECIES SCAVENGER GROUPS AND THEIR USE IN THE TREATMENT OF RESPIRATORY DISORDERS
Examiner: Andrew Freistein
Art Unit: 1626

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir/Madam:

Response and Amendment

This response is in reply to the office action mailed on March 27, 2007. This response is being submitted with a petition for a one-month extension to time to submit the response, with a corresponding Form 2038.

The examiner wrote, "Claims 1-9 and 12-28 are drawn to more than one inventive concept (as defined by PCT Rule 13), and accordingly, a restriction is required according to the provision of PCT Rule 13.2." Those alleged inventive concepts are:

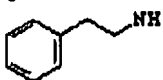
- Group I: Claims 1-9 and 23-25, drawn to a product of formula (I).
- Group II: Claims 12-14, drawn to a process for preparing formula (I).
- Group III: Claim 15, drawn to a composition comprising a compound of formula (I) for use as a medicament.
- Group IV: Claims 16-22 and 26, drawn to a method for treating or preventing a respiratory disorder.
- Group V: Claim 27, drawn to an inhalation device for administering a compound of formula (I).
- Group VI: Claim 28, drawn to a kit comprising an inhalation device for administering a compound of formula (I).

The examiner further wrote, "The inventions listed as Groups I-VI do not relate to a single general inventive concept under PCT 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: they

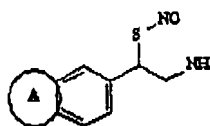
Inventor: Haj-Yehia, Abdullah I.
 Serial no.: 10/512,024

—2—

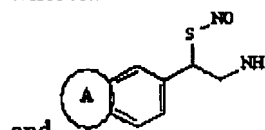
do not share the same structural element(s) that define the "special technical feature" necessary to specify a contribution over the prior art. . . . The structural moiety common

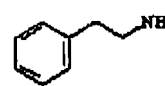
to Groups I-VI is ."

Applicant elects Group I with traverse. Why traverse? Claim 1 is the only independent claim and it has been amended to read on the following chemical structure:



wherein "A" stands for 5-7 membered heterocycle. The two structures,



and , are obviously different. The applicant restricted the invention in response to the first Office Action, deleting many structural possibilities, but now the Examiner asks that we delete even the medical applications of the compounds. Formula I has been, without prejudice, limited to cases when R¹ is -SNO, R³ with R⁴ form a saturated heterocycle, and R⁵ is H or alkyl.

The dependency amendments in claims 3, 4, 12, 27, and 28 are believed to still more emphasize unity of the invention.

The claims of the instant application relate to a clearly defined group of compounds, being substituted aminoethyl benzenes, wherein among the substituents there is at least one NO-donor selected from four structures (ONO, ONO₂, SNO, NONOate), and at least one ROS-scavenger selected from four structures (nitroxide, alkenyl, sulfhydryl, aryl); a process for preparing the compounds, and their use are further included. Aminoethyl benzenes of the prior art do not comprise either NO-donor or ROS-scavenger, let alone both. In response to a restriction requirement, the claims have been restricted to a fraction of original compounds, which are believed to be novel and inventive; and claim 1 is now believed to be novel and inventive, as well as all other claims, that now depend from claim 1, and cover a process and a use of said novel compounds. The amended claims are now believed to be allowable.

Since the examiner's restriction requirement did not take into consideration the feature that is believed by applicants as essential, it is respectfully requested that the

Inventor: Haj-Yehia, Abdullah I.
Serial no.: 10/512,024

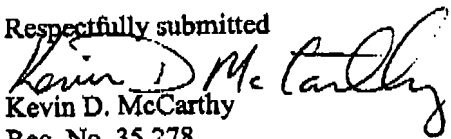
—3—

restriction requirement be kindly reconsidered. It is believed that the excluded compounds also comprise novel and inventive, useful, materials.

It is respectfully submitted that this application is currently in a condition for allowance and such allowance is earnestly solicited.

We are also re-submitting the power of attorney document and a letter sent to the counsel who inadvertently filed an assignment that should not have been recorded against this patent application. The letter is self-explanatory and it is expected the reputable law firm will correct its mistake regarding the improperly assigned assignment document. We therefore request the USPTO honor this power of attorney document, which was properly filed on November 16, 2006, and refused due to the other law firm's error.

Respectfully submitted



Kevin D. McCarthy
Reg. No. 35,278

Roach, Brown, McCarthy & Gruber, P.C.
1620 Liberty Building - 420 Main Street
Buffalo, New York 14202
(716) 852-0400